

United States Patent & Trademark Office; U.S. DEPARTMENT OF COMMERCE

PTO/SB/33 (07-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 59643.00074
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed Name _____	Application Number: 09/934,166 Filed: August 20, 2001
	First Named Inventor: Ian Rhodes
	Art Unit: 2135
	Examiner: Thanhnga B. Truong

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed

- ☒ Attorney or agent of record.
Registration No. 58,178

- ☐ Attorney or agent acting under 37 CFR 1.34.
Reg. No. is acting under 37 CFR 1.34 _____


Signature

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May 15, 2006
Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- ☐ *Total of _forms are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Confirmation No.: 8265

Ian RHODES

Art Unit: 2135

Application No.: 09/934,166

Examiner: Thanhnga B. Truong

Filed: August 20, 2001

Attorney Dkt. No.: 59643.00074

For: NETWORK ARRANGEMENT FOR COMMUNICATION

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

May 15, 2006

This is a Pre-Appeal Brief Request for Review from the final rejection set forth in an Office Action dated December 14, 2005 ("the Office Action"), and as further explained in an Advisory Action of March 30, 2006 ("the Advisory Action"), finally rejecting claims 1-24, 26-54, 56, and 59. Applicants submit that a *prima facie* case for obviousness has not been established, and that there is clear error with regard to at least one element of each of the independent claims.

The claim rejections are set forth in the Office Action at paragraphs 2-3 (the first of the two paragraphs numbered 3). Most of the claims are rejected under a combination of Jacobson and Boyle, but claims 24 and 59 were rejected under the combination of Jacobson, Boyle, and Thomas. There is clear error because the combination of references does not disclose or suggest all of the elements of the claims. In particular, the Office Action improperly construes the Jacobson's one network as the claimed two networks. Because one does not equal two, the rejection is clearly in error.

A detailed explanation of why “one network” does not equal “two networks” can be found in the response filed August 9, 2004, at pp. 19-21, in the response filed March 14, 2005, at pages 22-25 (which was entered after a Request for Continued Examination was filed April 12, 2005), in the response filed April 23, 2005, at pp. 23-26, and in the response filed March 14, 2006, at pp. 9-12, all of which are hereby incorporated by reference.

In summary, however, Jacobson relates to a network local security bridge for bridging first and second sides of a single network. The Advisory Action, at page 2, in the paragraph beginning “Secondly ...” acknowledged this fact, but maintained the rejection.

The Office Action and Advisory Action responded in two ways. First, they pointed out a lone comment in the background section of Jacobson that says “these types of networks.” This argument is clearly erroneous. All that Jacobson is doing by using the word “networks” is to identify a class or category of networks to which Jacobson’s teaching can be applied. By way of analogy, consider an application for a puppy sweater. Such a document may say that, previously, puppies with short hair have been cold during the winter. However, if the document describes a sweater that clothes a puppy on a first side and a second side, that is not disclosure of a sweater for two puppies. Indeed, the analogy reveals the shortcomings of the Office Action’s argument. Jacobson does not disclose or suggest that the first side of a network and a second side of the same network should be considered two networks. Indeed, Jacobson consistently and uniformly refers to its disclosure as relating to a **local** security bridge, between two sides of a **network**. One network does not equal two networks, just as one puppy does not equal two puppies. Thus, there is no rational basis for upholding the rejection on the basis that Jacobson is applicable to a class of networks.

The second argument that the Office Action and Advisory Action relied on was that the secondary reference, Boyle, shows two private networks. This is completely irrelevant. There are undoubtedly numerous references that talk about multiple networks. The question is whether one of ordinary skill in the art would be motivated to modify Jacobson's one network, and its **local** security bridge into two networks with something that could, by definition, **not** be a **local** security bridge. Saying that another reference teaches two (or more) networks and then willy-nilly modifying the primary reference, destroying the fundamental working principles thereof in the process, is not proper combination of references, but improper hindsight reconstruction.

Specifically, The Office Action's combination of Jacobson and Boyle in attempt to turn Jacobson's two sides of the same network with a **local** security bridge into two different networks with something that is, by definition, **not a local** security bridge, is impermissible hindsight reconstruction, as described in MPEP 2145. To establish a *prima facie* case in any 35 U.S.C. 103 case, it is essential that Office personnel find some motivation or suggestion to make the claimed invention in light of the prior art teachings. *See, e.g., In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) and MPEP 2144.08. The Office Action did not provide any motivation to combine the references in that manner, and accordingly failed to provide a *prima facie* case for obviousness. As MPEP Section 2143.01 indicates, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Accordingly, it is respectfully requested that this rejection be withdrawn.

The Advisory Action's entire response to the issue of motivation to combine is to assert that "the combination of teaching between Jacobson and Boyle is sufficient." This is legally

erroneous. 37 CFR 1.104(c)(2) and MPEP 706 require the Examiner to point out the particular part relied upon, when (as here) the references show or describe inventions other than that claimed by the applicant. A generalized assertion that “the combination of teaching between Jacobson and Boyle is sufficient” is sufficient to provide motivation to combine the references is both engages in the fallacy of *petitio principis* (in other words, it “begs the question” because it assumes that the combination would be made) and fails to meet the criteria demanded by law and the U.S.P.T.O.’s examination guidelines.

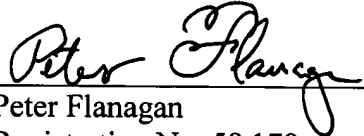
The Office Action itself made some additional allegations that it would have been obvious to combine other aspects of Boyle, such as “distribution of security information between first network and second network” Office Action at pp. 4-5, item 2(a)(iv)(1). The Office Action stated that it would have been “highly desirable” to implement multi-level security as taught by Boyle, and cited Boyle at column 2, lines 35-41. However, that passage merely asserts that such multi-level security is desirable in “**a non-secure environment**,” as stated by Boyle at column two line 36. The Office Action, however, did not establish the predicate question of whether Jacobson, with its “local security bridge” is an example of “**a non-secure environment**.” Indeed, Jacobson is replete with references to secure zones and local security bridges. These references all suggest that one of ordinary skill in the art would not view Jacobson’s network as “**a non-secure environment**.” Therefore, one of ordinary skill in the art clearly would not be motivated even to employ Boyle’s multi-level security (MLS) aspects.

Regardless, however, even if there were motivation to combine the MLS aspects of Boyle with Jacobson, there would be no motivation to modify Jacobson’s one network into two networks, because that is not what Boyle suggests produces any advantages or is otherwise desirable.

Thomas does not remedy these deficiencies, and the Office Action and Advisory did not dispute that it does not, but merely cited Thomas for other features. For similar reasons to those discussed above, the further combination of Jacobson, Boyle, and Thomas, is not properly motivated. Indeed, the Office Action and Advisory Action only address the combination of Jacobson with Thomas and the combination of Jacobson with Boyle, but not the three-way combination of Jacobson, Boyle, and Thomas. Accordingly, this is yet further clear error for which the rejection ought to be reversed.

For all of the above noted reasons, it is respectfully requested that the pending obviousness rejections be reversed, both because a *prima facie* case has not been established for combining the references, and because the combination of references does not and cannot modify Jacobson's one network with a **local security bridge** (*see* column 19, line 49-50, and column 20, line 7, as well as many other places in Jacobson) into two networks with something that would, by definition, **not** be a **local** security bridge between them. Again, Applicants submit that this is an improper piecemeal analysis of the art in an effort to show that the invention is obvious. Therefore, it is respectfully requested that all of the pending claims be allowed, and that this application be passed to issue.

Respectfully submitted,


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Check Nos. 14462 & 14464